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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/814,304	MILLER, ROBERT A.
	Examiner Doug Hutton	Art Unit 2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 September 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-34 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-31,33 and 34 is/are rejected.
 7) Claim(s) 32 is/are objected to.
 8)- Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 21 March 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

Applicant's Response

In Applicant's Response dated 16 September 2005, Applicant filed a Request for Continued Examination, amended Claims 1, 7, 11 and 16, and added new Claims 21-34.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 27-30:

The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim 27 recites a method comprising steps that may be performed by a human operator assisted only by pencil and paper. The claim does not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a "mental process," is not patentable subject matter.

"Phenomena of nature, though just discovered, "mental processes," abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work." (emphasis added) *Gottschalk v. Benson*, 75 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing* U.S.P.Q. 571 (1969).

Similarly, Claims 28-30 also recite steps that may be performed by a human operator assisted only by pencil and paper.

Applicant may obviate these rejections by amending the preamble of Claim 27 to
— A computerized method of formatting print data, comprising: —.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 7-20 remain rejected under 35 U.S.C. 102(e) as being anticipated by Mercer, U.S. Patent No. 6,547,830.

Claim 1:

Mercer discloses, *in a system for creating documents from processed data, an apparatus for forming processed data* (see Figures 1-2; see Column 3, Line 62 through Column 5, Line 32 – Mercer discloses this limitation in that the text display system comprises hardware and software that processes and displays documents on a cellular telephone display screen, as clearly indicated in the cited figures and text), *comprising*:

- *a data storage device for storing the processed data* (see Column 3, Line 62 through Column 5, Line 32 – Mercer discloses this limitation in that the system displays web pages using the Internet. The Internet web pages comprise “processed data” and are stored in various “data storage devices,” such as web servers.);
- *a form engine connected to said data storage device for formatting the processed data in said data storage device in accordance with predetermined high level rules* (see Figures 3A-D; see Column 5, Line 33 through Column 6, Line 34 – Mercer discloses this limitation in that the system includes Maximize Text Displayed software comprising a vertical distance reduction method, a font substitution method and a horizontal distance reduction method. The Maximize Text Displayed software is the “form engine,” and each of the methods are “predetermined high level rules.”) wherein said predetermined high level rules are applied until met or until a maximum of permitted change is reached, whichever occurs first (see Figures 4-8; see Column 6, Line 35 through Column 9, Line 10 – Mercer discloses this limitation in that the system performs each step of each

method until the “*high level rules are met*.” In the embodiment discussed in the cited figures and text, the methods are “*applied until met*.” Thus, the application of the “*high level rules*” “*until [the rules are] met*” “*occurs first*.”), and wherein said predetermined high level rules include a fail safe rule that ensures a guaranteed output of formatted data from the processed data when all said predetermined rules can not be met (Mercer discloses this limitation in that the methods for maximizing the text displayed are executed in conjunction with a browser. The browser *inherently* comprises a “*fail safe rule that ensures output when all said predetermined rules can not be met*” in that either the methods will fully execute with no problem and the browser will display the web page, or, upon encountering any problem during execution of the methods that will not permit display of the web page, the browser displays an error message. Accordingly, a “*guaranteed output*” is ensured in that either the rules will execute and the web page is displayed, or the rules will not execute and an error message is displayed. Either way, the “*output*” is “*of formatted data from the processed data*” in that the “*output*” comprises “*data*” that is “*formatted*” for display, wherein said displayed “*formatted data*” results “*from the processed data*.”); and

- *an output device connected to said form engine for outputting formatted data created from said form engine* (see Figure 1A – Mercer discloses this limitation in that the system comprises a cellular telephone screen that displays the web page in the revised format).

Claim 2:

Mercer discloses *the apparatus of Claim 1, wherein said predetermined high level rules use loose value tradeoffs for formatting processed data* (see Figures 5-8; see Column 7, Line 1 through Column 9, Line 10 – Mercer discloses this limitation in that the methods include “checkers” for determining whether any change is needed. For example, the font substitution method determines whether a character is smaller than a predetermined minimum, and, if so, then the character is revised. Also, Mercer discloses this limitation in that the system retrieves a web page from the Internet that will not fit onto a small display and fits the web page data onto one page of the display screen.).

Claim 3:

Mercer discloses *the apparatus of Claim 2, wherein said loose value tradeoffs are selected from a group including: fit all data on one page; cleanly define text columns; bold face first line of new text; and shrink photos proportionally with text* (as indicated in the above rejection for Claim 2, Mercer discloses this limitation).

Claim 4:

Mercer discloses *the apparatus of Claim 2, further comprising sublevels of loose value tradeoffs* (see Figures 5-8; see Column 7, Line 1 through Column 9, Line 10 – Mercer discloses this limitation in that the methods include “sub-checkers” for determining whether any change is needed. For example, the horizontal distance

reduction method determines whether the web page includes a plurality of columns, and, if so, revises the spacing between the columns.).

Claim 5:

Mercer discloses *the apparatus of Claim 3, wherein loose value tradeoff -fit all data on one page- further includes sublevel loose value trade offs: reduce font, shrink photos and graphics proportional with font, reduce length of some data fields, and shrink margin* (see Figures 5-8; see Column 7, Line 1 through Column 9, Line 10 – Mercer discloses this limitation in that the methods include “sub-checkers” that reduce the font of the web page text and reduce the horizontal and vertical distances of data fields in the web page).

Claims 7-10:

Claims 7-10 recite a system that corresponds to the system recited in Claims 2-5, respectively. Thus, Mercer discloses every limitation of Claims 7-10, as indicated in the above rejections for Claims 2-5.

Claim 11:

Mercer discloses, *in a system for creating documents from processed data, a method of forming processed data* (see Figures 1-2; see Column 3, Line 62 through Column 5, Line 32 – Mercer discloses this limitation in that the text display system comprises hardware and software that processes and displays documents on a cellular

telephone display screen, as clearly indicated in the cited figures and text), *comprising the steps of:*

- *providing a data storage device for storing the processed data* (see Figure 1B; see Column 4, Lines 44-52 – Mercer discloses this limitation in that the system includes a memory that stores web pages, as indicated in the cited figure and text);
- *adding processed data to said data storage device* (see Column 5, Lines 12-15 – Mercer discloses this limitation in that the system includes a browser that loads web pages into the memory);
- *connecting a form engine to said data storage device and formatting the processed data in accordance with predetermined high level rules* (see Figure 2; see Figures 3A-D; see Column 5, Lines 6-32; see Column 5, Line 33 through Column 6, Line 34 – Mercer discloses this limitation in that the system includes Maximize Text Displayed software that is connected to the memory, said software comprising a vertical distance reduction method, a font substitution method and a horizontal distance reduction method. The Maximize Text Displayed software is the “*form engine*,” and each of the method are “*predetermined high level rules*.”) wherein said predetermined high level rules are applied until met or until a maximum of permitted change is reached, whichever occurs first (see Figures 4-8; see Column 6, Line 35 through Column 9, Line 10 – Mercer discloses this limitation in that the system performs each step of each method until the “*high level rules are met*.” In the embodiment discussed in the

cited figures and text, the methods are “*applied until met.*” Thus, the application of the “*high level rules*” “*until [the rules are] met*” “*occurs first.*”), and wherein said predetermined high level rules include a fail safe rule that is applied to ensure a guaranteed output of formatted data from the processed data when all said predetermined rules can not be met (Mercer discloses this limitation in that the methods for maximizing the text displayed are executed in conjunction with a browser. The browser *inherently* comprises a “*fail safe rule that ensures output when all said predetermined rules can not be met*” in that either the methods will fully execute with no problem and the browser will display the web page, or, upon encountering any problem during execution of the methods that will not permit display of the web page, the browser displays an error message. Accordingly, a “*guaranteed output*” is ensured in that either the rules will execute and the web page is displayed, or the rules will not execute and an error message is displayed. Either way, the “*output*” is “*of formatted data from the processed data*” in that the “*output*” comprises “*data*” that is “*formatted*” for display, wherein said displayed “*formatted data*” results “*from the processed data.*”); and

- *connecting an output device to the form engine and outputting formatted data from said form engine* (see Figure 1A – Mercer discloses this limitation in that the system comprises a cellular telephone screen that displays the web page in the revised format).

Claim 12:

Mercer discloses *the method of Claim 11, wherein the predetermined high level rules use loose value tradeoffs for formatting processed data* (see Figures 5-8; see Column 7, Line 1 through Column 9, Line 10 – Mercer discloses this limitation in that the methods include “checkers” for determining whether any change is needed. For example, the font substitution method determines whether a character is smaller than a predetermined minimum, and, if so, then the character is revised. Also, Mercer discloses this limitation in that the system retrieves a web page from the Internet that will not fit onto a small display and fits the web page data onto one page of the display screen.).

Claim 13:

Mercer discloses *the method of Claim 12, further comprising the step of selecting said loose value tradeoffs from a group including: fit all data on one page; cleanly define text columns; bold face first line of new text; and shrink photos proportionally with text* (as indicated in the above rejection for Claim 12, Mercer discloses this limitation).

Claim 14:

Mercer discloses *the method of Claim 12, further comprising the step of adding sublevels of said loose value tradeoffs* (see Figures 5-8; see Column 7, Line 1 through Column 9, Line 10 – Mercer discloses this limitation in that the methods include “sub-checkers” for determining whether any change is needed. For example, the horizontal

distance reduction method determines whether the web page includes a plurality of columns, and, if so, revises the spacing between the columns.).

Claim 15:

Mercer discloses *the method of Claim 14, further comprising the step of adding sublevel loose value trade offs: reduce font, shrink photos and graphics proportional with font, reduce length of some data fields, and shrink margins* (see Figures 5-8; see Column 7, Line 1 through Column 9, Line 10 – Mercer discloses this limitation in that the methods include “sub-checkers” that reduce the font of the web page text and reduce the horizontal and vertical distances of data fields in the web page).

Claims 16-20:

Claims 16-20 recite computer software corresponding to the apparatus recited in Claims 1-5, respectively. Thus, because the invention disclosed in Mercer involves processes executed by software, Mercer discloses every limitation of Claims 16-20, as indicated in the above rejections for Claims 1-5.

Claims 27, 30, 31 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Mercer.

Claim 27:

Mercer discloses a *method of formatting print data* (see Figures 1-2; see Column 3, Line 62 through Column 5, Line 32 – Mercer discloses this limitation in that the text display system comprises hardware and software that processes and displays documents on a cellular telephone display screen, as clearly indicated in the cited figures and text. The documents are “*print data.*”), comprising:

- *establishing a higher level formatting rule for the print data* (see Figures 3A-D; see Column 5, Line 33 through Column 6, Line 34 – Mercer discloses this limitation in that the system includes Maximize Text Displayed software comprising a vertical distance reduction method, a font substitution method and a horizontal distance reduction method. The maximization of the displayed text performed by the Maximize Text Displayed software is the “*higher level formatting rule.*”);
- *establishing lower level formatting rules configured to change the print data to conform to the higher level rule* (see Figures 3A-D; see Column 5, Line 33 through Column 6, Line 34 – Mercer discloses this limitation in that the system includes Maximize Text Displayed software comprising a vertical distance reduction method, a font substitution method and a horizontal distance reduction method. The methods are the “*lower level formatting rules.*”);
- *establishing a fail safe rule that when applied to the print data conforms the print data to the higher level rule* (Mercer discloses this limitation in that the methods for maximizing the text displayed are executed in conjunction with a browser).

The browser *inherently* comprises a “*fail safe rule*” in that either the methods will fully execute with no problem and the browser will display the web page, or, upon encountering any problem during execution of the methods that will not permit display of the web page, the browser displays an error message. Accordingly, either the rules will execute and the web page is displayed, or the rules will not execute and an error message is displayed. Whenever the rules execute and the web page is displayed, the “*fail safe rule*” is “*applied to the print data*” and “*conforms the print data to the higher level rule.*”);

- *applying the lower level rules to the print data* (see Figures 3A-D; see Column 5, Line 33 through Column 6, Line 34 – Mercer discloses this limitation, as clearly indicated in the cited figures and text); and
- *applying the fail safe rule to the print data if applying the lower level rules to the print data does not conform the print data to the higher level rule* (as indicated in the above discussion, the “*fail safe rule*” will be applied upon encountering any problem during execution of the methods that will not permit display of the web page).

Claim 30:

Mercer discloses *the method of Claim 27 wherein the print data comprises data representing one or more of static text, dynamic text, static graphics or dynamic graphics* (see Figures 3A and 3B – Mercer discloses this limitation, as clearly indicated in the cited figures).

Claims 31 and 34:

Claims 31 and 34 recite computer software comprising the method recited in Claims 27 and 30, respectively. Thus, because the invention disclosed in Mercer involves processes executed by software, Mercer discloses every limitation of Claims 31 and 34, as indicated in the above rejections for Claims 27 and 30.

Claims 1-20 remain rejected under 35 U.S.C. 102(e) as being anticipated by Kojima, U.S. Patent No. 6,633,401.

Claim 1:

Kojima discloses, *in a system for creating documents from processed data, an apparatus for forming processed data* (see Figure 1; see Column 1, Lines 51-60; see Column 3, Lines 7-12 – Kojima discloses this limitation in that the image forming system creates an image based on transmitted data and processes the data for printing it in hard copy), comprising:

- *a data storage device for storing the processed data* (see Column 4, Lines 4-19 – Kojima discloses this limitation in that the image forming system comprises RAM that stores the email data, the facsimile data and/or the print data that is received from external sources);
- *a form engine connected to said data storage device for formatting the processed data in said data storage device in accordance with predetermined high level rules* (see Column 4, Lines 57-65; see Column 5, Lines 41-56; see Column 7,

Lines 56-67; see Column 9, Line 49 through Column 11, Line 34 – Kojima discloses this limitation in that the system comprises a sheet-saving print process that includes line pitch and font size reduction rules and an “ignore form feed code” rule for reformatting the data that is to be printed. The sheet-saving print process is the “*form engine*,” and each of the rules are “*predetermined high level rules*.”) wherein said predetermined high level rules are applied until met or until a maximum of permitted change is reached, whichever occurs first (see Column 11, Lines 35-65 – Kojima discloses this limitation in that the system performs all rules of the sheet-saving print process until the “*high level rules are met*.” In the embodiment discussed in the cited figures and text, the rules are “*applied until met*.” Thus, the application of the “*high level rules*” “*until [the rules are] met*” “*occurs first*.”), and wherein said predetermined high level rules include a fail safe rule that ensures a guaranteed output of formatted data from the processed data when all said predetermined rules can not be met (see Column 4, Lines 20-24; see Column 9, Lines 49-55 – Kojima discloses this limitation in that the system includes both “*default*” formats and “*designated*” formats. When executing the intermediate data generating process, the system relies on the “*default*” format if a “*designated*” format is not associated with the processed data. Thus, a “*guaranteed output of formatted data from the processed data*” is ensured in that the data will be printed using either the “*default*” format or the “*designated*” format.); and

- *an output device connected to said form engine for outputting formatted data created from said form engine* (see Figure 1; see Column 11, Lines 16-34 – Kojima discloses this limitation in that the system comprises a printer, as indicated in the cited figure and text).

Claim 2:

Kojima discloses *the apparatus of Claim 1, wherein said predetermined high level rules use loose value tradeoffs for formatting processed data* (see Column 4, Lines 37-56; see Column 10, Lines 15-32 – Kojima discloses this limitation in that the system condenses the “multiple-page” data onto a single page and prints it, as indicated in the cited text).

Claim 3:

Kojima discloses *the apparatus of Claim 2, wherein said loose value tradeoffs are selected from a group including: fit all data on one page; cleanly define text columns; bold face first line of new text; and shrink photos proportionally with text* (as indicated in the above rejection for Claim 2, the system discloses “fitting all data on one page”).

Claim 4:

Kojima discloses *the apparatus of Claim 2, further comprising sublevels of loose value tradeoffs* (see Column 5, Lines 41-56 – Kojima discloses this limitation in that the

system the image forming system comprises the line pitch and font size reduction rules for reformatting the data. Thus, Kojima discloses “reducing font” and “reducing length of some data fields.”).

Claim 5:

Kojima discloses *the apparatus of Claim 3, wherein loose value tradeoff -fit all data on one page- further includes sublevel loose value trade offs: reduce font, shrink photos and graphics proportional with font, reduce length of some data fields, and shrink margin* (as indicated in the above rejection for Claim 4, the system discloses “reducing font” and “reducing length of some data fields” for reformatting the data).

Claim 6:

Kojima discloses *the apparatus of Claim 1, wherein the output device is a printer* (as indicated in the above rejection for Claim 1, the image forming system discloses a printer).

Claims 7-10:

Claims 7-10 recite a system that corresponds to the system recited in Claims 2-5, respectively. Thus, Kojima discloses every limitation of Claims 7-10, as indicated in the above rejections for Claims 2-5.

Claim 11:

Kojima discloses, *in a system for creating documents from processed data, a method of forming processed data* (see Figure 1; see Column 1, Lines 51-60; see Column 3, Lines 7-12 – Kojima discloses this limitation in that the image forming system creates an image based on transmitted data and processes the data for printing it in hard copy), *comprising the steps of:*

- *providing a data storage device for storing the processed data* (see Column 4, Lines 4-19 – Kojima discloses this limitation in that the image forming system comprises RAM that stores the email data, the facsimile data and/or the print data that is received from external sources);
- *adding processed data to said data storage device* (see Column 4, Lines 57-65 – Kojima discloses this limitation in that the system receives data and store it in RAM);
- *connecting a form engine to said data storage device for formatting the processed data in said data storage device in accordance with predetermined high level rules* (see Column 4, Lines 57-65; see Column 5, Lines 41-56; see Column 7, Lines 56-67; see Column 9, Line 49 through Column 11, Line 34 – Kojima discloses this limitation in that the system comprises a sheet-saving print process that includes line pitch and font size reduction rules and an “ignore form feed code” rule for reformatting the data that is to be printed. The sheet-saving print process is the “*form engine*,” and each of the rules are “*predetermined high level rules*.”) *wherein said predetermined high level rules are applied until met or*

until a maximum of permitted change is reached, whichever occurs first (see Column 11, Lines 35-65 – Kojima discloses this limitation in that the system performs all rules of the sheet-saving print process until the “*high level rules are met.*” In the embodiment discussed in the cited figures and text, the rules are “*applied until met.*” Thus, the application of the “*high level rules*” “*until [the rules are] met*” “*occurs first.*”), and wherein said predetermined high level rules include a fail safe rule that is applied to ensure a guaranteed output of formatted data from the processed data when all said predetermined rules can not be met (see Column 4, Lines 20-24; see Column 9, Lines 49-55 – Kojima discloses this limitation in that the system includes both “*default*” formats and “*designated*” formats. When executing the intermediate data generating process, the system relies on the “*default*” format if a “*designated*” format is not associated with the processed data. Thus, a “*guaranteed output of formatted data from the processed data*” is ensured in that the data will be printed using either the “*default*” format or the “*designated*” format.); and

- *connecting an output device to said form engine for outputting formatted data created from said form engine* (see Figure 1; see Column 11, Lines 16-34 – Kojima discloses this limitation in that the system comprises a printer, as indicated in the cited figure and text).

Claim 12:

Kojima discloses *the method of Claim 11, wherein said predetermined high level rules use loose value tradeoffs for formatting processed data* (see Column 4, Lines 37-56; see Column 10, Lines 15-32 – Kojima discloses this limitation in that the system condenses the “multiple-page” data onto a single page and prints it, as indicated in the cited text).

Claim 13:

Kojima discloses *the method of Claim 12, further comprising the step of selecting said loose value tradeoffs from a group including: fit all data on one page; cleanly define text columns; bold face first line of new text; and shrink photos proportionally with text* (as indicated in the above rejection for Claim 12, the system discloses “fitting all data on one page”).

Claim 14:

Kojima discloses *the method of Claim 12, further comprising the step of adding sublevels of loose value tradeoffs* (see Column 5, Lines 41-56 – Kojima discloses this limitation in that the system the image forming system comprises the line pitch and font size reduction rules for reformatting the data, Thus, Kojima discloses “reducing font” and “reducing length of some data fields.”).

Claim 15:

Kojima discloses *the method of Claim 14, further comprising the step of adding sublevel loose value tradeoffs: reduce font, shrink photos and graphics proportional with font, reduce length of some data fields, and shrink margins* (as indicated in the above rejection for Claim 14, the system discloses “reducing font” and “reducing length of some data fields” for reformatting the data).

Claims 16-20:

Claims 16-20 recite computer software corresponding to the apparatus recited in Claims 1-5, respectively. Thus, because the invention disclosed in Kojima involves processes executed by software, Kojima discloses every limitation of Claims 16-20 as indicated in the above rejections for Claims 1-5.

Claims 27, 30, 31 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Kojima.

Claim 27:

Kojima discloses *a method of formatting print data* (see Figure 1; see Column 1, Lines 51-60; see Column 3, Lines 7-12 – Kojima discloses this limitation in that the image forming system creates an image based on transmitted data and processes the data for printing it in hard copy), comprising:

- *establishing a higher level formatting rule for the print data* (see Column 4, Lines 57-65; see Column 5, Lines 41-56; see Column 7, Lines 56-67; see Column 9,

Line 49 through Column 11, Line 34 – Kojima discloses this limitation in that the system comprises a sheet-saving print process that includes line pitch and font size reduction rules and an “ignore form feed code” rule for reformatting the data that is to be printed. The goal of saving sheets is the “*higher level formatting rule.*”);

- *establishing lower level formatting rules configured to change the print data to conform to the higher level rule* (see Column 4, Lines 57-65; see Column 5, Lines 41-56; see Column 7, Lines 56-67; see Column 9, Line 49 through Column 11, Line 34 – Kojima discloses this limitation in that the system comprises a sheet-saving print process that includes line pitch and font size reduction rules and an “ignore form feed code” rule for reformatting the data that is to be printed. Each of the rules are “*lower level formatting rules.*”);
- *establishing a fail safe rule that when applied to the print data conforms the print data to the higher level rule* (see Column 4, Lines 20-24; see Column 9, Lines 49-55 – Kojima discloses this limitation in that the system includes both “default” formats and “designated” formats. When executing the intermediate data generating process, the system relies on the “default” format if a “designated” format is not associated with the processed data. Thus, a output of the data is ensured in that the data will be printed using either the “default” format or the “designated” format.);
- *applying the lower level rules to the print data* (see Column 11, Lines 35-65 – Kojima discloses this limitation, as clearly indicated in the cited text); and

- *applying the fail safe rule to the print data if applying the lower level rules to the print data does not conform the print data to the higher level rule* (as indicated in the above discussion, the “fail safe rule” will be applied to ensure output of the print data).

Claim 30:

Kojima discloses *the method of Claim 27 wherein the print data comprises data representing one or more of static text, dynamic text, static graphics or dynamic graphics* (see Column 1, Line 44 through Column 2, Line 42 – Kojima discloses this limitation, as clearly indicated in the cited text).

Claims 31 and 34:

Claims 31 and 34 recite computer software comprising the method recited in Claims 27 and 30, respectively. Thus, because the invention disclosed in Kojima involves processes executed by software, Kojima discloses every limitation of Claims 31 and 34, as indicated in the above rejections for Claims 27 and 30.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mercer.

Claim 21:

As indicated in the above discussion, Mercer discloses every element of Claim 1.

Mercer fails to expressly disclose a fail safe rule that comprises *cutting data to one page*. However, at the time the invention was made, it would have been obvious to one having ordinary skill in the art (i.e., a computer programmer) to have employed a fail safe rule that comprised *cutting data to one page*. If a computer programmer wanted to ensure that a print job comprised printing the print job data onto a single sheet, then he could have selected from among some obvious design choices. These obvious design choices included: 1) reducing the size of the print data; 2) changing the font of the print data; 3) reducing/eliminating the margins of the print data; and/or 4) deleting portions of the print data. All of these obvious design choices comprised “*cutting data to one page*” and would have been employed by a computer programmer for the purpose of ensuring that a print job produced only a single page of print data.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Mercer, to include a fail safe rule that comprises *cutting data to one page*, for the purpose of ensuring that a print job produced only a single page of print data

Claim 22:

Mercer fails to expressly disclose a fail safe rule that comprises *wrapping data to two pages*. However, at the time the invention was made, it would have been obvious to one having ordinary skill in the art (i.e., a computer programmer) to have employed a fail safe rule that comprised *wrapping data to two pages*. If a computer programmer wanted to limit all print jobs to a maximum of two pages, then he would have specified that any original print data having a length between one and two printed pages required no modification and was to be printed in its original format. Thus, for any print job that met the condition of having a length between one and two pages, the print data would have inherently been “[wrapped] to two pages” in that the print data was to be printed onto two sheets of paper.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Mercer, to include a fail safe rule that comprises *wrapping data to two pages*, for the purpose of limiting all print jobs to a maximum of two pages

Claims 23 and 24:

Claims 23 and 24 recite a method corresponding to the apparatus recited in Claims 21 and 22, respectively. Thus, Mercer discloses every limitation of Claims 23 and 24, as indicated in the above rejections for Claims 21 and 22.

Claims 25 and 26:

Claims 25 and 26 recite computer software corresponding to the apparatus recited in Claims 21 and 22, respectively. Thus, because the invention disclosed in Mercer involves processes executed by software, Mercer discloses every limitation of Claims 25 and 26, as indicated in the above rejections for Claims 21 and 22.

Claim 29:

As indicated in the above discussion, Mercer discloses every element of Claim 27.

Mercer fails to expressly disclose a higher level formatting rule that comprises *fitting all of the print data on one page* and a fail safe rule that comprises *cutting the print data*. However, at the time the invention was made, it would have been obvious to one having ordinary skill in the art (i.e., a computer programmer) to have employed a higher level formatting rule that comprises *fitting all of the print data on one page* and a fail safe rule that comprises *cutting the print data*. If a computer programmer wanted to ensure that a print job comprised printing the print job data onto a single sheet, then he could have selected from among some obvious design choices. These obvious design choices included: 1) reducing the size of the print data; 2) changing the font of the print data; 3) reducing/eliminating the margins of the print data; and/or 4) deleting portions of the print data. All of these obvious design choices comprised “*cutting the print data*” and would have been employed by a computer programmer for the purpose of ensuring that a print job produced only a single page of print data.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Mercer, to include a higher level formatting rule that comprises *fitting all of the print data on one page* and a fail safe rule that comprises *cutting the print data*, for the purpose of ensuring that a print job produced only a single page of print data

Claim 33:

Claim 33 recites computer software comprising the method recited in Claim 29. Thus, because the invention disclosed in Mercer involves processes executed by software, Mercer discloses every limitation of Claim 33, as indicated in the above rejection for Claim 29.

Claims 21-26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kojima.

Claim 21:

As indicated in the above discussion, Kojima discloses every element of Claim 1. Kojima fails to expressly disclose a fail safe rule that comprises *cutting data to one page*. However, at the time the invention was made, it would have been obvious to one having ordinary skill in the art (i.e., a computer programmer) to have employed a fail safe rule that comprised *cutting data to one page*. If a computer programmer wanted to ensure that a print job comprised printing all of the print data onto a single

sheet, then he could have selected from among some obvious design choices. These obvious design choices included: 1) reducing the size of the print data; 2) changing the font of the print data; 3) reducing/eliminating the margins of the print data; and/or 4) deleting portions of the print data. All of these obvious design choices comprised "*cutting data to one page*" and would have been employed by a computer programmer for the purpose of ensuring that a print job produced only a single page of print data.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Kojima, to include a fail safe rule that comprises *cutting data to one page*, for the purpose of ensuring that a print job produced only a single page of print data

Claim 22:

Kojima fails to expressly disclose a fail safe rule that comprises *wrapping data to two pages*. However, at the time the invention was made, it would have been obvious to one having ordinary skill in the art (i.e., a computer programmer) to have employed a fail safe rule that comprised *wrapping data to two pages*. If a computer programmer wanted to limit all print jobs to a maximum of two pages, then he would have specified that any original print data having a length between one and two printed pages required no modification and was to be printed in its original format. Thus, for any print job that met the condition of having a length between one and two pages, the print data would have inherently been "[wrapped] to two pages" in that the print data was to be printed onto two sheets of paper.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Kojima, to include a fail safe rule that comprises *wrapping data to two pages*, for the purpose of limiting all print jobs to a maximum of two pages

Claims 23 and 24:

Claims 23 and 24 recite a method corresponding to the apparatus recited in Claims 21 and 22, respectively. Thus, Kojima discloses every limitation of Claims 23 and 24, as indicated in the above rejections for Claims 21 and 22.

Claims 25 and 26:

Claims 25 and 26 recite computer software corresponding to the apparatus recited in Claims 21 and 22, respectively. Thus, because the invention disclosed in Kojima involves processes executed by software, Kojima discloses every limitation of Claims 25 and 26, as indicated in the above rejections for Claims 21 and 22.

Claim 29:

As indicated in the above discussion, Kojima discloses every element of Claim 27.

Kojima fails to expressly disclose a higher level formatting rule that comprises *fitting all of the print data on one page* and a fail safe rule that comprises *cutting the*

print data. However, at the time the invention was made, it would have been obvious to one having ordinary skill in the art (i.e., a computer programmer) to have employed a higher level formatting rule that comprises *fitting all of the print data on one page* and a fail safe rule that comprises *cutting the print data*. If a computer programmer wanted to ensure that a print job comprised printing the print job data onto a single sheet, then he could have selected from among some obvious design choices. These obvious design choices included: 1) reducing the size of the print data; 2) changing the font of the print data; 3) reducing/eliminating the margins of the print data; and/or 4) deleting portions of the print data. All of these obvious design choices comprised “*cutting the print data*” and would have been employed by a computer programmer for the purpose of ensuring that a print job produced only a single page of print data.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Kojima, to include a higher level formatting rule that comprises *fitting all of the print data on one page* and a fail safe rule that comprises *cutting the print data*, for the purpose of ensuring that a print job produced only a single page of print data

Claim 33:

Claim 33 recites computer software comprising the method recited in Claim 29. Thus, because the invention disclosed in Kojima involves processes executed by software, Kojima discloses every limitation of Claim 33, as indicated in the above rejection for Claim 29.

Claim 6 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Mercer, in view of Schilit et al., U.S. Patent No. 6,670,968.

Claim 6:

As indicated in the above discussion, Mercer discloses every element of Claim 1.

Mercer fails to expressly disclose an *output device [that] is a printer*.

Schilit teaches a text display system that retrieves a web page using a cellular telephone and prints the web page on a *printer* (see Figure 5B; see Figure 6C; see Column 5, Lines 30-51; see Column 8, Line 60 through Column 9, Line 9 – Schilit teaches this limitation in that the display system comprises a cellular telephone that displays a reformatted web page and allows the user to print the web page, as indicated in the cited figures and text) for the purpose of obtaining a hard copy of the retrieved web page.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the text display system, disclosed in Mercer, to include an *output device [that] is a printer* for the purpose of obtaining a hard copy of the retrieved web page, as taught by Schilit.

Allowable Subject Matter

Claims 28 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims. Additionally, the rejection of Claim 28 under 35 U.S.C. 101 must be obviated.

The following is a statement of reasons for the indication of allowable subject matter:

Claims 28 and 32:

The prior art fails to disclose or suggest the combination of limitations recited in Claims 28 and 32.

Response to Arguments

Applicant submitted no arguments in the response dated 16 September 2005.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
September 30, 2005



**DOUG HUTTON
PATENT EXAMINER
TECH CENTER 2100**